

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/525,274	Applicant(s) SCHMITT ET AL.	
	Examiner Kathleen A. McNelis	Art Unit 1742	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06/15/2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 15 June 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-7, 10 and 11.
 Claim(s) withdrawn from consideration: 8 and 9.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

Continuation of 3. NOTE: The following amendments change the scope of the finally rejected claims and will therefore require additional consideration and/or search:

- 1) the deletion of calcium fluoride as an additive in claims 1 and 11,
- 2) the amended limitation to claim 5 changing "a cellulose ether" to "carboxymethyl cellulose", and
- 3) the change of dependency of claim 7.

Continuation of 11. does NOT place the application in condition for allowance because:

- 1) Applicant argues that the 01/18/2007 Office action was not properly made final because new rejection grounds were applied due to amended limitations to the claims. The new grounds were improperly applied to claims 3, 4 and 6 which were NOT amended and M.P.E.P 706.07(a) states that a rejection will not be made final if it includes a rejection on newly cited art of any claim not amended by applicant or owner in spite of the fact that other claims may have been amended to require newly cited art.

Examiner's response is that claims 3, 6 and 6 depend from amended claim(s).

- 2) Applicant affirms the election of sodium borate in claims 1-7, 10 and 11 for prosecution on the merits with traverse.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

- 3) Arguments related to the rejection of claims 1, 2 and 4 under 35 U.S.C. 103(a) over CN '218 are based on amended claim limitations which change the scope of claim 1 from the finally rejected claims and will therefore require additional consideration and/or search.

- 4) Arguments regarding the rejection of claim 3 as unpatentable over CN '218 in view of Morris are based on amended claim limitations which change the scope of claim 1 from the finally rejected claims and will therefore require additional consideration and/or search. See also p. 11 of 01/18/2007 Office action, response to argument 3.

- 5) Arguments regarding rejections of claims 5-7, 10 and 11 under 35 U.S.C. 103(a) over CN '218 are based on amended claim limitations which change the scope of claim 1 from the finally rejected claims and will therefore require additional consideration and/or search.

- 6) Regarding the rejection of claims 1-7 and 11 under 35 U.S.C. 103(a) over CN '218 in view of SU '867 or Stewart et al. or Lewis et al., SU '867 is non-analogous to CN '218 since SU '867 applies a coating to a different type of pellet (Fuel flux ore) whereas CN '218 is an agglomeration process. Stewart relates to a flux in a beneficiation process which is irrelevant to the claimed agglomeration process. Lewis is unrelated to an agglomeration process.

Examiner's response is that SU '867 discloses consolidating a pellet containing fuel, flux and ore and is analogous since CN '218 also discloses consolidation of flux and ore. SU '867 teaches that both borax and boric acid are both used as water soluble B-containing substances, and are therefore substitutes in a consolidation process. Stewart et al. discloses that the flux comprising either boric acid or borax is beneficial during the heating and reduction of ore, therefore boric acid or borax are substitutes in an ore heating process. The pellets of CN '218 are used for steelmaking, and Lewis et al. teaches that boric acid and borax are substitutes in a steelmaking process.

- 7) Regarding the rejection of claims 1-7 and 11 under 35 U.S.C. 103(a) over Banyai et al., sodium tetraborate is mentioned in 3-12 as a comparative example. Since other binders had superior results, Banyai teaches against the use of sodium tetraborate and does not render the invention obvious.

Examiner's response is that Banyai et al. discloses the claimed invention as discussed p. 8 of the 01/18/2007 Office action. Examiner does not find any statement in Banyai et al. that the composition in sample 3-12 is clearly inferior and should not be used, nor does the fact that some of the other compositions had superior wet drop numbers or wet or dry compressive strengths change the fact that the composition is disclosed in the prior art.

- 8) Regarding the rejection of claim 10 under 35 U.S.C. 103(a) over CN '218 in view of SU '867 or Stewart et al. or Lewis et al. and JP '243, Ceramics Monthly and digitalfire.com, the fact that borax, colemanite or ulexite may be equivalents in the process for modifying slag (JP '243) in ceramic bodies (Ceramics monthly) or in making pottery (digitalfire.com) does not mean that such compounds would perform the same in the claimed agglomeration process.

Examiner's response is that the use of the pellets of CN '218 is as raw material in steelmaking, specifically to smelt iron (abstract). JP '243 teaches that borax, colemanite or ulexite are substitutes in smelting iron ores. Digitalfire.com teaches Gillespie Borate was developed to match the chemical composition of Gerstley borate, and that Gerstley borate contained a lot of Ulexite, therefore the properties are similar. Ceramics Monthly discloses that the compositions of Gerstley, Laguna, Murray's and Gillespie borates are similar. Since digitalfire.com and Ceramics monthly teach that the substitute materials have the same or similar compositions, the same or similar properties would be expected regardless of the application.

KAM
06/26/2007

